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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,275

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Douglas Allard

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HOWREY LLP-CA

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EXAMINER

CECIL, TERRY K

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/724,275	<b>Applicant(s)</b> ALLARD, DOUGLAS	
	<b>Examiner</b> Mr. Terry K. Cecil	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12-22-2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,10,12-19,21,23-30,32,34-41 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-7, 10, 12-19, 21, 23-30, 32, 34-41, 44-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

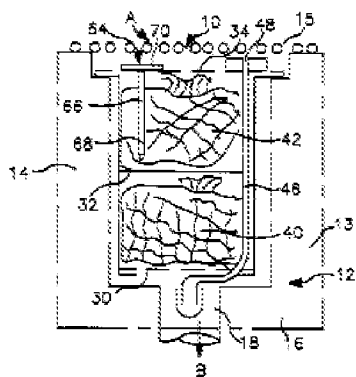
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 40 is rejected under 35 U.S.C. 102(b) as being anticipated by Bamer et al. (U.S. 5,820,762). Bamer teaches a method of treating water runoffs where runoff from surrounding



elevated structures is directed by gravity to a water collection point (the area around the inlet of the storm drain) and through an inlet 15. The water is then passed through a basket 20 where filtering and separating hydrocarbons from the water occurs. A bypass route 48 is also through the apparatus to a water collection point. An outlet 18 is provided for filtered water.

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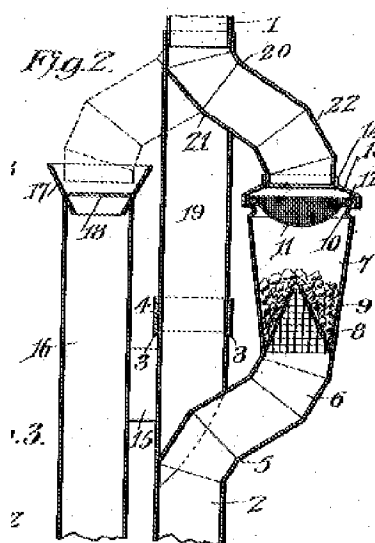
***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

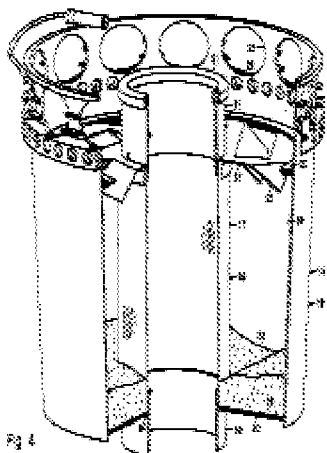


4. Claims 1, 3, 5-7, 10, 12-16, 18-19, 21, 23-26, 28-30, 32, 34-37 and 39-41, 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (U.S. 0,971,578), in view of Fleischmann (U.S. 6,793,811). Walker teaches a filter apparatus for filtering rainwater e.g. the roofs of buildings. As shown in the figures, three paths through the apparatus are provided. The conducting and guiding spout acts as a valve that is moved to determine the flow route therethrough. The first flow route 6

includes a plurality of filters (8, 9, 11) wherein 11 is basket-shaped and 11+12 is removable and is considered to be a "cartridge". The second route 19 (a bypass) delivers water to the same outlet as the first route. A third route (16) also includes a removable filter (17+18) and delivers flow to a second outlet.

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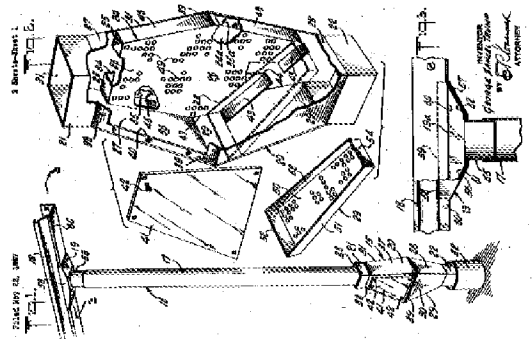
Walker teaches a basket filter and a second filter. But doesn't teach the second filter to be capable of filtering hydrocarbons from the fluid. However, such is taught by Fleischmann.



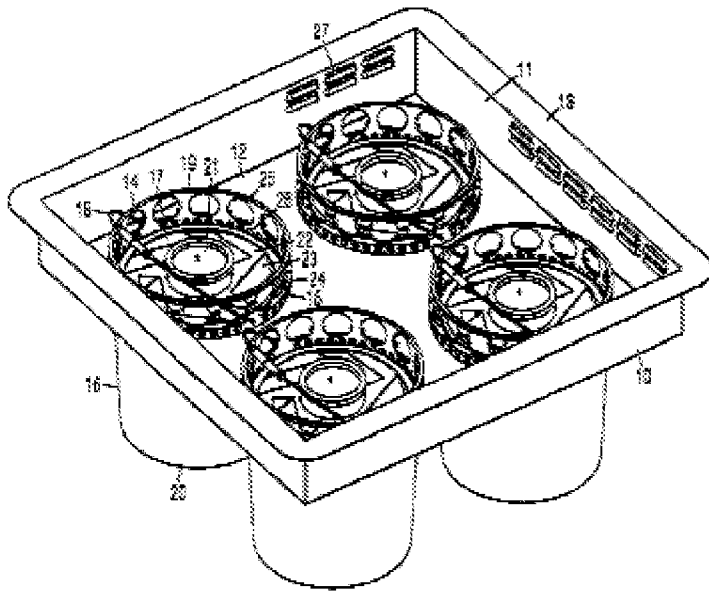
Fleischmann teaches a water filtration cartridge including an outer housing surrounding a hydrocarbon adsorptive material—e.g. perlite (col. 5, lines 37-44). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the cartridge filter of Fleischmann as the second filter of Walker, since Fleischmann teaches the benefits of filtering hydrocarbons

and easier lifting of a filter cartridge for repair and/or replacement.

5. Claims 1, 3, 5-7, 10, 12-14, 19, 21, 23-24, 28-30, 32, 34-35, 40-41, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trump (U.S. 3,465,885) in view of Fleischmann. In trump when removable basket filter cartridge 23 becomes clogged, all flow is directed to an alternate route to flow through 24 to the same outlet 22. When 24 becomes clogged, all flow is directed to yet another alternate route to flow through outlets 33 (figure 1).



Trump teaches a filter basket but not two filtering elements wherein at least one comprises an enclosure and an absorbent material capable of filtering hydrocarbons. However, such is taught by Fleischmann.



Fleischmann teaches various embodiments of his filter cartridge system, wherein each filter can be considered to include a basket or an enclosure including, for example, perlite inside (col. 5, lines 37-44). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the cartridge filter unit of Fleischmann as the filters of Walker, since Fleischmann teaches the benefits of filtering hydrocarbons and easier lifting of filter cartridges for repair and/or replacement. It also would have been obvious since the filtering system of Fleischmann is also for filtering runoff water and simple substitution to perform the same function is within ordinary skill.

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6. Claims 17, 27 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the above prior art rejections of sections 5 and 6 above, and in further view of Macpherson et al. (U.S. 6,821,427). These claims add the limitation of chitosan. Macpherson teaches a chitosan gel for treating stormwater. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the chitosan of Macpherson in any of the aforementioned downspout filters, since Macpherson teaches the benefit of reducing the amount of contaminants in stormwater.

#### ***Response to Arguments***

7. Applicant's arguments filed 12-22-2008 have been fully considered but they are not persuasive.

- In regards to the 102 rejection of claim 40, Applicant argues that Bamer does not teach the step of "providing a bypass route for said water to pass through the apparatus to one or more water collection points" since the route provided by tube 48 is for collection purposes. However, the Examiner contends that since tube 48 provides a different route out of the apparatus (other than through the outlet), the claimed bypass route is provided (the bottom outlet is bypassed). It is noted that the "bypass route" is broadly claimed.
- Concerning the rejection of Walker in view of Fleischmann, Applicant argues that the combination does not teach the claimed alternate route through the apparatus. This is not found to be convincing for at least two reasons. Firstly, in the position shown in figure 1 of Walker, water flowing through the apparatus clearly does not flow through the filter and is an "alternate route". Secondly, upon modification with Fleischmann, the overflow 21 of the

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filter basket of Fleischmann provides the alternate route to the first outlet. “When bucket 16 is full, the runoff can still drain through central overflow tube 21, albeit unfiltered” (col. 5, lines 20-23).

- Concerning the rejection of Trump with Fleischmann, Applicant argues that the combination fails to teach the claimed bypass route (means, etc.) since water entering interior 24 can flow through either apertures 49 or through the apertures of basket 27. This is not found to be convincing since water that does not flow through 27 flows through apertures 49 bypassing the basket and necessarily providing an alternate route through the filter. Applicant's assertion that both filters are portions of the same filter is unconvincing. Also, as stated above, upon modification with Fleischmann, the overflow 21 of the filter basket of Fleischmann provides an alternate route to the first outlet.
- Despite Applicant's remarks to the contrary, both references are for filtering runoff water (e.g. rainwater). Because of this and because hydrocarbons are a known environmental contaminant, sufficient reasons are provided for combining the references.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Terry K. Cecil whose telephone number is (571) 272-1138. The examiner can normally be reached on 8:00a-4:30p M-F..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mr. Terry K. Cecil/  
Primary Examiner, Art Unit 1797

tkc